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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/176,274	10/21/1998	HIDEAKI OHSHIMA	862.2492	7987

5514 7590 11/17/2003

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2672

21

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/176,274

Applicant(s)

OHSHIMA ET AL.

Examiner

Jeffery A. Brier

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/21/98 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/18/03 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 07/18/03 have been fully considered but they are not persuasive.

Applicant contends the amendments are supported by the specification, however, applicant is mixing the disclosure of objects associated with pages 12-26 with the disclosure of images associated with pages 27-42. Objects and images are different things, see applicants figure 5 and page 20 lines 14-15 which describes the data structure that describes the objects and see applicants page 27 lines 18-25 which describes the sources of the images as for example a digital camera, thus, images are pixel data while objects are high level data structure. The processing of high level data structure is different than the processing of low level pixel data, thus, it would be improper to apply the processing of the images to objects.

At page 13 last paragraph applicant points to portions of the specification which allegedly supports the amending the claims to claim that each image is comprised of objects having assigned attributes. The specific locations have been reviewed and found to fail to support the amendments made to the independent claims because these locations describes at the most referencing processed images with object links while the amendments are made to the beginning of the claims before the images have been processed and seem to be claiming the photos are objects while the specification at the cited portions describes processed images being referenced with object links. Additionally these locations do not describe the claimed rendering attributes corresponding to the size and the output positions. The specification at pages 12-26 describes rendering attributes associated with objects but not images.

The pending claims do not clearly claim the elected invention and corresponding embodiment.

### ***Drawings***

3. The drawings are objected to because in block S66 of figure 11 "display" is misspelled.. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 2672

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11, 15-25 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The pending claims do not clearly claim the elected embodiment for the reasons given above in the response to arguments.

Claim 1:

At line 6 "the size" lacks antecedent basis in the claim.

At line 6 "the output" lacks antecedent basis in the claim.

The pending claims do not clearly claim the elected embodiment for the reasons given above in the response to arguments.

Claim 15:

At line 9 "the size" lacks antecedent basis in the claim.

At line 9 "the output" lacks antecedent basis in the claim.

Claim 29:

At line 9 "the size" lacks antecedent basis in the claim.

At lines 9 and 10 "the output" lacks antecedent basis in the claim.

Art Unit: 2672

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

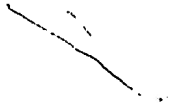
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-11, 15-25 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Cancelled claims 12-14 and 26-28, group III, claimed objects which is described at pages 12-26. Pages 12-26 used objects as the best way to change the size of windows and to determine the placement of objects within the windows.

Originally filed claims 1-11, 15-25 and 29, group II, claimed images which is described at pages 27-42. Pages 27-42 used the term images because photos are being edited, see figures 9, 10, 12 and 14, photos are images.

Applicant is attempting to amend independent claims 1, 15 and 29 with features present at pages 12-26 and claimed in the non elected group III. Thus, applicant is attempting to take that which was described at pages 12-26 and add it to that which was described at pages 27-42. The specification as filed did not describe doing this, Thus, one of ordinary skill in the art would not have been conveyed by the originally filed specification and claims that the amended claims that applicant had possession of the currently claimed invention



Art Unit: 2672

8. A prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713).

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

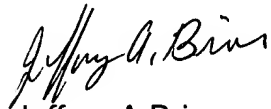
**or faxed to:**

**(703) 872-9306 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Art Unit: 2672

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Jeffery A Brier  
Primary Examiner  
Art Unit 2672